

Remarks

In view of the following remarks, favorable reconsideration of the final office action is respectfully requested. Upon entry of this amendment, claims 1-2, 4, 10-12, 14, 16-21, 28, 32-33, 50-53 and 58 remain in this application. Claims 3, 5-9, 13, 15, 22-27, 29-31, and 54-57 have been canceled. Claims 34-49 stand withdrawn.

1. Completeness

The Examiner is thanked for the completeness, clarity and timeliness of his responses.

2. Drawings

Applicants thank Examiner for the indication that the Drawings are approved.

3. Specification

Applicants concur with Examiner's interpretation of "silica-containing article used in the manufacture of optical fiber."

4. Allowable Subject Matter

The Examiner is thanked for the indication that claims 1, 2, 4, 10-12, 14, 16-21, 28, 32, 33, 50-52 and 58 are allowed.

4. § 103 Rejections

The Examiner has rejected claim 53 under 35 U.S.C. §103(a) as being unpatentable for obviousness over Japanese Patent No. 02-258643 (Tsuji et al.) in view of US Patent No. 4,632,848 (Gossett et al.) or US Patent No. 6,211,282 (Yamashita et al.).

Respectfully, the rejection is flawed and should, therefore, be withdrawn. In particular, claim 53 is believed allowable because none of the cited references, alone or in combination, teach or suggest applying a protective layer consisting essentially of an alkyl ammonium compound, an aryl ammonium compound, or a wax to a consolidated glass surface of an article used in optical fiber manufacture.

The Examiner asserts that Tsuji et al. teach coating a silica-containing article used in the manufacture of optical fiber with a temporary/removable resin layer such as a polyester systems, polyacryl system, polyvinyl system, polyurethane system, silicone system, etc. Broadly, Examiner is correct. However, the key distinctions are that Tsuji et al. teaches a class of coatings which are: 1) easily peeled off from the glass perform, i.e., they are meant to

be, and are, easily peelable, and 2) the class of coatings are polymer coatings. Since the term “etc.” is used in Tsuji et al., which means “And other unspecified things of the same class,” (See Webster’s II New College Dictionary), then only other polymeric coatings would be included in the class. A protective layer consisting essentially of a wax is not a polymer. Accordingly, contrary to Examiner’s assertion, there is no suggestion in Tsuji et al. to select a wax to coat a consolidated glass surface of an article used in optical fiber manufacture. Thus, there is no motivation to select the coatings described in 4,632,848 (Gossett et al.) or 6,211,282 (Yamashita et al.) in the first place. As such, the motivation for selection of the combination of Tsuji et al. and 4,632,848 (Gossett et al.) or 6,211,282 (Yamashita et al.) is lacking. And the rejection of claim 53 should, therefore, be withdrawn

Additionally, a person of ordinary skill in the art would not be motivated to select the prior art waxes taught in the backgrounds of 4,632,848 (Gossett et al.) or 6,211,282 (Yamashita et al.) as an equivalent of the peelable coatings in Tsuji et al because neither of these prior art waxes are “*easily peelable*.” Gossett et al ‘848 teach that, in the prior art, a wax may be used to protect articles (Col. 2, lines 2-3). However, Gosset also clearly states that the difficulty in removal of the waxes (unwrapping) is a drawback of their use. In particular, the difficulty in removal results in the use of solvents or hot slightly alkaline solutions to remove them. Thus, the waxes taught in the prior art are, by their very nature, not “easily” peelable. In particular, if the class of coatings taught in Tsuji et al. were substituted with the wax coatings taught in the Gosset et al. background, the overall function of being “easily peelable” taught in Tsuji would be destroyed. Accordingly, it is ill conceived that, if one of ordinary skill in the art were looking to substitute another coating for the peelable ones in Tsuji, that such person would look to, and select, coatings which are, in fact, not easily peelable, the combination of Tsuji et al. and Gosset is also improper for this reason.

It should be noted that the improved coatings of Gosset (which are easily peelable) include a starch or a starch derivative and a wetting agent. Accordingly, they do not consist essentially a wax as required by the claims. The “consisting essentially of” language is only open to inclusion of ingredients that would not “materially affect the basic and novel properties of the invention. PPG Industries v. Guardian Indus. Corp., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1354 (Fed. Cir. 1998).

Similarly, the combination of Yamashita et al. and Tsuji et al. is also flawed. First, the combination is improper because a wax is not in the same class as the coatings described in Tsuji et al., i.e., polymer coatings. Second, the coatings taught in the Description of the Related Art in Yamashita et al. do not teach a coating which is “easily peelable.” The coatings in Yamashita et al. include 1) a so-called oily wax type in which a paraffin wax is dispersed in a petroleum-based solvent and 2) where the paraffin wax is mixed with calcium carbonate powder and dispersed in a petroleum-based solvent. In each case, the wax is not easily peelable. In particular, (Col. 1, line 44-50) states that these strippable (as opposed to peelable) coatings call for the use of solvents for removal. In summary, the coatings of Yamashita et al. would not be selected as an equivalent, because: 1) they are not in an equivalent coating class, and 2) they are not peelable do thereby destroying the removal method taught in Tsuji et al. Accordingly, the combination is flawed and does not lead to the claimed invention. As such, the 103(a) rejection of claim 53 should be withdrawn.

Additionally, there is no motivation, contrary to Examiner’s assertion, that the Tsuji reference is in any need of improvement. Tsuji is directed to an *easily* peelable coating. In other words, the Tsuji polymer coating method works adequately. There is no motivation whatsoever to select either Gosset et al or Yamashita et al. in the first place, as the method is *not in need of improvement*. As such, the references as a whole would not suggestion the desirability, and thus the motivation for making the modification. At best, Examiner has shown that it might be obvious to try a prior art wax material of Gosset et al or Yamashita et al. However, it is well settled that “obvious to try” is not the standard of patentability. Moreover, in each of the Gosset patent, improvements were made to the prior art waxes, thereby teaching away from the use of these prior art waxes relied upon by Examiner. Accordingly, the obviousness rejection of claim 53 should be withdrawn.

5. Conclusion

Based upon the above amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims and a prompt Notice of Allowance thereon.

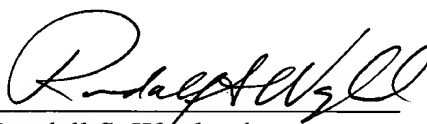
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Randall S. Wayland at 607-974-0463.

Respectfully submitted,

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